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12D

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/287,377 04/07/99 D'AMATO R 05213-0272

HM22/0913

MARY ANTHONY MERCHANT
JONES & ASKEW
2400 MONARCH TOWER
3424 PEACHTREE ROAD N E
ATLANTA GA 30326

EXAMINER

JONES, D

ART UNIT

PAPER NUMBER

1614

DATE MAILED:

09/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
08/287,377

Applicant(s)

D'Amato

Examiner

Dwayne C. Jones

Group Art Unit
1614



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

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--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a composition, classified in classes 546, 548, 560, 562 and 564, subclasses 200, 548, 102, 492, and 180, respectively .
 - II. Claims 13-20, drawn to methods of use, classified in class 514, subclasses 323, 423, 532, 569 and 617.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as with protamine or interferon or fumagillin.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. Claim 3 is generic to a plurality of disclosed patentably distinct species comprising the various types of steroids listed. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
5. Claim 5 is generic to a plurality of disclosed patentably distinct species comprising the various types of NSAIDs listed. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
6. Claim 7 is generic to a plurality of disclosed patentably distinct species comprising the various types of compounds listed, particularly compounds A through H. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
7. Claim 9 is generic to a plurality of disclosed patentably distinct species comprising the various types compounds listed, particularly compounds I through S. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
8. Claim 12 is generic to a plurality of disclosed patentably distinct species comprising the various types compounds listed, particularly compounds III through XIV. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
9. Claims 18 and 20 are generic to a plurality of disclosed patentably distinct species comprising the various types angiogenic dependent diseases listed Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.
10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. A telephone call to the attorney is not required where the restriction requirement is complex, see MPEP Sect 812.01.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4634.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


DWAYNE C. JONES
PRIMARY EXAMINER

Tech. Ctr. 1614

September 12, 2000

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